

REMARKS

Claims 1, 3-19 and 21 are pending and stand rejected. No claims have been amended, canceled or added by this communication.

Reconsideration of this application is respectfully urged.

It is noted that the amendments and arguments filed on December 21, 2004 were persuasive in eliminating the rejection of claims 1-22 under 35 U.S.C. §103(a) using U.S. Patent 4,831,526 to Luchs et al. (Luchs) in view of U.S. Patent 5,191,522 to Bosco et al. (Bosco), and that a new grounds of rejection has been raised in the present Office Action.

Claims 1, 3-19 and 21 now stand rejected under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Bosco and further in view of U.S. Patent 6,839,689 to Aieta et al. (Aieta).

In support of this rejection the Examiner states:

Luchs and Bosco do not explicitly disclose wherein the insurance underwriting instrument is one of a fidelity bond or surety bond.

However, this feature is known in the art, as evidenced by Aieta. In particular, Aieta suggests wherein the insurance underwriting instrument is one of a fidelity bond or a surety bond (See Aieta, Col. 5, lines 1-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Aieta within the combined teachings of Bosco Luchs with the motivation of facilitating the provision of private information of a client to a server in a secure, highly automated, efficient manner that imposes minimal physical burden and no uncovered risk to the client or server (See Aieta, Col. 2, lines 40-44).

The Applicants respectfully traverse this rejection because the Aieta patent is not prior art to claims 1, 3-19 and 21 of the present application as the portion of the disclosure upon which the Examiner relies to reject claims 1, 3-19 and 21 has an effective filing date of January 10, 2001, which is after the December 16, 1999 effective filing date of the present application. Specifically, the Aieta patent issued from an application that was a continuation-in-part of application no. 09/433,013, (the '013 application) filed on November 3, 1999, now Patent No. 6,269,349, which claimed priority of U.S. Provisional Application No. 60/154,945, filed September 21, 1999. The subject matter of Col. 5, lines 1-27 of Aieta is not supported by the disclosure of the '013 application and was apparently added when the application, from which the Aieta patent issued, was filed on January 10, 2001. Consequently, the subject matter of Col. 5, lines 1-27 is not entitled to the earlier filing date of the '013 application.

In the absence of Aieta, it is clear from the record of this application that Luch in view of Bosco fail to teach or suggest the fidelity bond and surety bond features of claims 1, 3-19 and 21. Accordingly, withdrawal of this rejection is respectfully urged.


Favorable reconsideration of this application is respectfully requested as it is believed that all outstanding issues have been addressed herein and, further, that claims 1, 3-19 and 21 are in condition for allowance. Should there be any questions or matters whose resolution may be advanced by a telephone call, the examiner is cordially invited to contact applicants' undersigned attorney at his number listed below.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17,

which are associated with this communication, or credit any overpayment to Deposit Account

No. 50-2061.

Respectfully submitted,



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